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09/913,745

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Kathleen R. McKeown

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06/01/2004

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EXAMINER

CORRIELUS, JEAN M

ART UNIT

PAPER NUMBER

2172

DATE MAILED: 06/01/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,745

Applicant(s)

MCKEOWN ET AL.

Examiner

Jean M Corrielus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 13-19, 21 and 22 is/are rejected.
- 7) ☒ Claim(s) 5, 12 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date Z.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response the request for reconsideration received on March 05, 2004, in which claims 1-22 are presented for further examination.

Response to Arguments

2. Applicant's arguments filed March 5, 2004 have been fully considered but they are not persuasive. (see examiner's remark).

Information Disclosure Statement

3. The information disclosure statement filed March 5, 2004 complies with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file. The information referred to therein has been considered as to the merits.

Claim Rejections - 35 U.S.C. 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 8 and 15 recite the use of generating a summary of a plurality of related document in a collection. However the body of the claims does not perform what is set forth in the preamble. There is no mention of "generating a summary of a plurality of related document in a collection" in the body of the claims. It is not clear to one having ordinary skill in the art to understand how the use of performing sentence generation is similar to generating a summary of a plurality of documents as stated in the applicants' remark. Applicants are advised to amend the claims to tie up the preamble and the body of the claims. Applicant should be careful not to introduce any new matter into the disclosure in the claims

Claim Rejections - 35 U.S.C. 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 6-11, 13-19 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Razin et al., (hereinafter "Razin") US Patent no. 6,098,034.

As to claim 1, Razin discloses the claimed "extracting phrases having focus elements from the plurality of documents" extracting phrases in a document by automatic extraction from the documents of sequence of words constituting significant user phrases that are significantly similar but not identical to significant user phrases (col.2, lines 43-60; col.3, lines 20-63); "performing phrase intersection analysis on the extracted phrases to generate intersection table" an automatic generation of suggested phrasing for the

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approximately matched phrasings that conforms its phrasing to the standard (col.2, lines 43-60); “performing temporal processing on the phrases in the phrases to generate intersection table” identifying phrases of a document to create a preliminary list of standard phrases and analyzing the suffix tree (col.2, lines 43-60). Razin does not disclose the use of “performing sentence generation using the phrases in the phase intersection table”. However, Razin discloses a sentence suffix trees which is defined as a trie representing a set of sequence comprising all of the suffixed of all of the sentences in a given document (col.7, line 60-col.8, line 30). It would have been obvious to one of ordinary skill in the art of data processing, at the time the present invention was made to modify Razin’s system, wherein the standardizing document, provided therein (see Razin’s col.3, lines 20-30) would incorporate the use of performing sentence generation using the phrases. One having ordinary skill in the art would have found it motivated to use a modification because that would provide Razin’s system the enhanced capability of ensuring the syntactic coherence of the document, thereby maximizing the efficiency and speed of suffix tree construction while minimizing its complexity.

As to claim 2, Razin discloses the claimed □representing the phrases in tree structure having root nodes and children nodes□ (col.7, lines 55-67; col.12, lines 58-67); □selecting those tree structures with verb root nodes□ (col.12, lines 58-67); □comparing the selected root nodes to the other root nodes to identify identical nodes□ (col.15, line 25-col.16, lines 56); □applying paraphrasing rules to non-identical root nodes to determine if non identical nodes are equivalent□ (col. 17, lines 30-col.18, line 67; col.16,

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lines 42-57); □evaluating the children nodes of those tree structures where the parent nodes are identical or equivalent□(col. 17, lines 30-col.18, line 67).

As to claim 3, Razin discloses the claimed “wherein the tree structure is a DSYNT tree structure” as heuristic tree structure (col.2, lines 48-52; col.10, lines 40-65; col.12, lines 58-67).

As to claim 4, Razin discloses the claimed “wherein the paraphrasing rules are selected from the group consisting of ordering of sentence components, main clause versus a relative clause, different syntactic categories, change in grammatical features, omission of an empty head, transformation of one part of speech to another, and semantically related words” (col.8, line 14-31).

As to claim 6, Razin discloses the claim “a phrase divergence processing operation” (col.9, lines 3-56).

As to claim 7, Razin discloses the claimed “wherein the sentence generation includes mapping phrases to an input format of a language generation engine and operating the language generation engine” (col.8, lines 15-31; col.9, lines 3-56).

As to claims 8-11 and 13-15:

Claims 8-11 and 13-15 are computer system to perform the method of claims 1-4 and 6-7.

In addition, Razin discloses the claimed “a storage device for storing the documents in

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the collection" (col.8, lines 32-53); "a lexical database" (col.7, line 15-col.8, line 52); "a processing subsystem, the processing subsystem being operatively coupled to the storage device and the lexical database, the processing subsystem being programmed to access the documents in the storage device (col.7, line 15-col.8, line 52); and "using the lexical database to extract phrases having focus elements from the plurality of documents" extracting phrases in a document by automatic extraction from the documents of sequence of words constituting significant user phrases that are significantly similar but not identical to significant user phrases (col.2, lines 43-60; col.3, lines 20-63).

Claims 16-20 and 21-22:

Claims 16-20 and 21-22 are computer usable medium having computer readable program code embodied therein to perform the method of claims 1-4 and 6-7. They are, therefore, rejected under the same rationale.

Allowable Subject Matter

Claims 5, 12 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Remark

(A). Applicants asserted that claims 1-22 satisfy the requirement of 35 USC 112, second. The examiner disagrees with the precedent assertion. Claims 1, 8 and 15 recite the use of "generating a summary of a plurality of related document in a collection".

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There is no mentioned of “generating a summary of a plurality of related document in a collection” in the body of the claims. However the body of the claims does not perform what is set forth in the preamble. It is not clear to one having ordinary skill in the art to understand how the use of performing sentence generation is equivalent to generating a summary of a plurality of documents as stated in the applicants’ remark. Based on the analysis provided above the rejection under 35 USC 112, second sustains.

(B). Applicants asserted that ‘034 patent does not disclose extracting phrases from multiple document and does not discloses temporal processing of extracted phrases. In response, the examiner disagrees with the precedent assertion. However, when read and analyzed in the light of the specification, the invention as claimed does not support applicants’ assertion. Moreover, the claims do not capture the essence of the invention as argued in applicants’ remark page 3. It is important to note that applicants are interpreting the claims very narrow without considering the broad teachings of the reference used in the rejection. In paper no. 6, the examiner went through the claims phrase by phrase and referred to the prior art column and line number as to where he has drawn the correspondences between applicants’ claims phrases and prior art. By failing to address these correspondences, applicants have failed to rebut the examiner’s prima facie case of obviousness uses for a different purpose which does not alter the conclusion that its use in a prior art device would be prima facie obvious from the purpose disclosed in the reference. Furthermore, the ‘034 patent discloses the recited limitations “extracting phrases from multiple document” as a means for extracting phrases in a document by automatic extraction from the documents of sequence of words constituting significant

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user phrases that are significantly similar but not identical to significant user phrases (col.2, lines 43-60; col.3, lines 20-63); and “temporal processing of extracted phrases” as a means for identifying phrases of a document to create a preliminary list of standard phrases and analyzing the suffix tree (col.2, lines 43-60). Therefore, the aforementioned assertion is moot.

C. Applicants asserted that there is simply no motivation for Razin to perform the claimed step of temporal processing. In response, the examiner disagrees with the preceding allegations. However, appellants are interpreting the claim very narrow without considering the broad teaching of the references used in the rejection. Appellants are reminded that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. Furthermore, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya USPQ 607 (CCPA 1975). On the other hand, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. Hence the 35 U.S.C 103 is hereby sustained.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (703) 306-3035. The examiner can normally be reached on Monday - Friday (12:00pm - 7:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jean M. Corrielus

Patent Examiner

May 25, 2004